

REMARKS

Applicant thanks the Examiner for the Written Office Action. Applicant further thanks the Examiner for the telephone conversation with Mr. Starkweather on July 26, 2004 and for the interviews with Mr. Mike King on July 30, 2004 both regarding the election/restriction of the claims, the claims' scope and requested the Examiner to provide a written Office Action. Still further, the Applicant thanks the Examiner for the complete Office Action and specificity of the rejections with respect to the references cited.

Claims 1-12 have been withdrawn. Claims 13-20 have been elected. Claims 13-18 and 20 have been amended, claim 19 has been cancelled, and claims 21-32 are new. Claims 13 and 27 are independent claims.

ELECTION/RESTRICTION

With regards the substantive portion of the Written Office Action, the Office Action required restriction to one of two sets of claims, namely Claims 1-12, drawn to a device, and Claims 13-20, drawn to a method. The Office Action noted that during the telephone conversation with Mr. Starkweather, "a provisional election was made with traverse to prosecute" Claims 13-20. In light of the telephone conversation on 7/26/04 with Mr. Starkweather, the Examiner withdrew Claims 1-12 from further consideration. Applicant hereby affirms the election of claims 13-20.

35 U.S.C. §112, FIRST PARAGRAPH

Claims 13-20 have been rejected under 35 U.S.C. §112, first paragraph as based on a disclosure which is not enabling. Specifically, the examiner asserts that the limitations of a)

lacquered based paints/polishes instead of residue, b) cleaning of textiles, c) cleaning with solvent vapors, where the absorbent pad prevents solvent from contacting directly with the carpet, and d) a vapor transfer box comprising an absorbent pad and a vapor transfer chamber are critical or essential to the practice of the invention, but not included in the claims, is not enabled by the disclosure.

Additionally, the Examiner asserts that the claims require an absorbent pad in addition to the vapor transfer chamber.

The claims have been amended to clarify that the residue is lacquer based. Additionally, the claims have been amended to indicate that the surface is a textile. Applicant respectfully asserts that the specific feature of the vapor transfer chamber is not a necessary component of the present invention. Specifically, page 9, paragraph [0028] teaches that the absorbent pad may be placed directly atop a textile surface. Accordingly, independent claim 13 has not been amended to include the limitation of a vapor transfer chamber.

Accordingly, Applicant respectfully requests reconsideration of the rejection for at least these reasons.

35 U.S.C. § 112, SECOND PARAGRAPH

Claims 13-20 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Claim 19 has been cancelled and claims 13-15 and 17-18 have been amended to clarify the interaction between the solvent, solvent vapors, and the lacquer based residue. Specifically, claim 13 has been amended to indicate that the residue is removed from a textile surface. Claim 14 has been

amended to clarify the steps of performing the method. Claim 15 has been amended to clarify the structural relationship between the vapor transfer box, the absorbent pad, and the solvent vapor chamber. Claims 17-18 have been amended to correct dependency and clarify the removal of solvent.

Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §112, second paragraph, have been addressed and resolved. Applicant respectfully requests reconsideration of the rejection of claims 13-20 and that the claims be allowed.

35 U.S.C. §102 TO WOODFORD AND NELSON

35 U.S.C. §102 TO WOODFORD

Claims 13-19 have been rejected under 35 U.S.C. §102 to United States Patent Number 4,353,145 to Woodford. In formulating this rejection, the Examiner asserts that Woodford teaches a method for cleaning rugs by applying a solvent to the absorbent pad 28 within the housing device 12, placing the device above the surface of the carpet, and removing the device after the residue has softened, the softening inherently resulting from scrubbing the carpet with scrubber pads in combination with the addition of cleaning solution.

It is well settled that under 35 U.S.C. §102 "an invention is anticipated if...all the claim limitations [are] shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim." Richardson v. Suzuki Motor Co., Ltd., 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Accordingly, only if each limitation is literally disclosed by the prior art reference is the claim anticipated.

Independent claim 13 includes the steps of applying a solvent to an absorbent pad and allowing solvent vapors to soften the lacquer based residue. Woodford is a floor cleaner/polisher. Woodford teaches that a hot sudsing (detergent) cleaning solution is dispensed directly onto a carpet, and pads rotatingly engage the carpet or rug to agitate the pile (See Abstract). Applicant respectfully submits that the Woodford cleaner does not use a solvent, and does not use solvent vapors to soften a lacquer based residue. As a result, every element of the claimed invention is not present in the prior art. Reconsideration of the rejection is respectfully submitted.

35 U.S.C. §102 TO NELSON

Claims 13-19 have been rejected under 35 U.S.C. §102 to United States Patent Number 6,260,232 to Nelson. In formulating this rejection, the Examiner asserts that Nelson teaches cleaning a surface by applying a solvent to the absorbent pad 536 within a device housing 513 (Fig. 16), placing the housing device 513 over the surface to be cleaned, and removing the housing from the surface.

As discussed above, independent claim 13 includes the steps of applying a solvent to an absorbent pad and allowing solvent vapors to soften the lacquer based residue. Nelson teaches applying a cleaning liquid to a surface and scrubbing the surface. It is respectfully submitted that Nelson fails to teach using a solvent, and using solvent vapors to soften a lacquer based residue.

Consequently, Applicant respectfully submits that the rejection under 35 U.S.C. §102 to Woodford and/or Nelson is improper for at least these reasons. Applicant respectfully requests reconsideration of the rejection and allowance of independent claim 13. Applicant further respectfully submits that claims 14-26 be allowed as they are dependent on allowable independent claim 13.

35 U.S.C. § 103 TO WOODFORD/RACETTE AND NELSON/RACETTE

Claim 20 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,353,145 to Woodford in view of U.S. Patent No. 5,876,461 to Racette et al. and over U.S. Patent No. 6,260,232 to Nelson in view of U.S. Patent No. 5,876,461 to Racette et al.

35 U.S.C. §103 To Woodford/Racette

In formulating this rejection, the examiner admits that Woodford fails to teach the solvent recited in claim 20, and admits that Woodford teaches cleaning carpets with a detergent solution.

In order to satisfy the limitation of claim 20, the Examiner relies on Racette et al. for teaching cleaning textiles using glycol ether to dissolve and loosen contaminants from textile surfaces. The Examiner asserts that it would have been obvious to a person of ordinary skill in the art to have modified the method of Woodford to include the composition of Racette et al., for the purposes of removing contaminants from the substrate surface.

Applicant respectfully submits that independent claim 13 recites the use of solvent vapors to soften a lacquer based residue. As discussed above, Woodford fails to teach this limitation. Accordingly, Applicant submits that even the combination of Woodford with Racette fails to teach the claim limitations of independent claim 13.

35 U.S.C. §103(a) To Nelson/Racette

In formulating this rejection, the examiner admits that Nelson fails to teach the solvent recited in claim 20, and admits that Nelson teaches cleaning carpets with a detergent solution. In order to satisfy the limitation of claim 20, the Examiner relies on Racette et al. for teaching cleaning textiles using glycol ether to dissolve and loosen contaminants from textile surfaces.

The Examiner asserts that it would have been obvious to a person of ordinary skill in the art to have modified the method of Woodford to include the composition of Racette et al., for the purposes of removing contaminants from the substrate surface.

Applicant respectfully submits that independent claim 13 recites the use of solvent vapors to soften a lacquer based residue. Similar to Woodford, Nelson fails to teach this limitation. Accordingly, Applicant submits that even the combination of Nelson with Racette fails to teach the claim limitations of independent claim 13.

The PTO has the burden to establish a prima facie case of obviousness. In re Fine, 837 F.2d, 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); MPEP 2142. “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP §2143.03. As discussed above, neither Woodford nor Nelson teach all limitations of the independent claims. Neither Woodford nor Nelson teach the use of solvent vapors to soften a lacquer based residue. Consequently, Applicant respectfully submits that the Examiner has not established a prima facie case of obviousness, and therefore, the claim rejection under 35 U.S.C. §103(a) is improper for at least this reason.

CONCLUSION

As a result of the presented remarks, Applicant asserts that independent claim 13 is in condition for prompt allowance. Consequently, dependent claims 14-26, which depend from this independent claim, are also in condition for prompt allowance.

Should additional information be required regarding this response, the Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael W. Starkweather", written over a horizontal line.

Michael W. Starkweather

Reg. No. 34,441

Attorney for Applicant

Date: November 12, 2004

9035 South 1300 East

Suite 200

Sandy, UT 84094

Telephone (801) 272-8368

Fax (801) 748-1030

Amendments to the Drawings

None